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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,385	09/26/2003	Masashi Eguchi	031085	2735

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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

SIKRI, ANISH

ART UNIT	PAPER NUMBER
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2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/670,385

Applicant(s)

EGUCHI ET AL.

Examiner

Anish Sikri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/17/2006 09/26/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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DETAILED ACTION

Information Disclosure Statement

The information disclosure statement submitted on 4/23/2004 been considered by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, and 2 are rejected under 35 U.S.C. 102(b) as being anticipated over Hutton et al. (US Patent 6,108,704).

Consider **Claim 1**, Hutton et al clearly discloses an electronic mail system comprising: a mail server which transmits and receives an electronic mail (Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16); and means for converting an electronic mail address of a destination terminal into a network address (Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16); wherein the mail server obtains the network address by the means for converting by using the electronic mail

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address included in the received electronic mail (Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16), and transmits the electronic mail to the obtained network address (Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16). Hutton clearly shows that an electronic mail is transmitted via the network with the corresponding network address.

Consider **Claim 2**, Hutton et al clearly discloses the electronic mail system according to claim 1, wherein when the destination terminal is assigned with a network address (Fig 9, Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16), the destination terminal notifies the means for converting with the terminal name of the destination terminal and the network address (Fig 9, Col 10 Lines 46-56), and updates the network address included in the address conversion data (Fig 8, Col 10 Lines 25-35). Hutton clearly discloses on how the network updates the addresses of the users, which are logged and updated in the database along with time-stamped email storage (Fig 8, Col 10 Lines 25-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3, 4, 5, 6, 7, 8, 9, 10, 11, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutton et al (US Pat 6,108,704), in view of Ranalli et al (US Patent 6,748,057).

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Consider **Claim 3**, Hutton et al in view of Rannali et al fails to disclose an electronic mail system according to claim 2, wherein the destination terminal is an Internet facsimile machine which can carry out an image communication by the Internet. Nonetheless, Rannali et al clearly discloses electronic mail system wherein the destination terminal is an Internet facsimile machine, which can carry out an image communication by the Internet (Rannali et al, Col 7 Lines 35-38, Col 17 Lines 5-9). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the use of internet facsimile connected to the electronic mail system taught by Hutton et al's system, for the purpose of transmitting information to multiple destinations.

Consider **Claim 4**, Hutton et al in view of Rannali et al clearly discloses an electronic mail system comprising: an address conversion unit which stores address conversion data for converting an electronic mail address of a destination terminal into a network address (Fig 8, Col 10 Lines 25-35); an electronic mail reception unit which receives electronic mail (Fig 8, Col 10 Lines 25-35), and an electronic mail transmission unit which transmits the electronic mail to the obtained network address (Fig 9, Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16). But Hutton et al in view of Rannali et al fails to disclose an inquiry unit, which obtains the network address from the address conversion unit by using an electronic mail address of a destination terminal included in the received electronic mail. Nonetheless, Rannali et al clearly discloses an inquiry unit, which obtains the network address from the address

conversion unit by using an electronic mail address of a destination terminal included in the received electronic mail (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of inquiry unit (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32) taught by Rannali et al in Hutton et al's system, for the purpose of having database of user information (Rannali et al, Col 6 Lines 35-65, Col 7 Lines 1-30) for users of the systems.

Consider **Claim 5**, Hutton et al fails to disclose electronic mail system according to claim 4, comprising: a directory server which includes the address conversion unit; and an electronic mail server which includes the electronic mail reception unit, the inquiry unit, and the electronic mail transmission unit. Nonetheless, Rannali et al discloses a directory server according to claim 4, comprising: a directory server which includes the address conversion unit; and an electronic mail server which includes the electronic mail reception unit, the inquiry unit, and the electronic mail transmission unit (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of Directory Server (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32) taught by Rannali et al in Hutton et al's system, for the purpose of having a directory server which aids in providing unified messaging service which includes directory service, LDAP, fax, and mail etc, to provide users with different methods of communication.

Consider **Claim 6**, Hutton et al fails to disclose electronic mail system according to claim 4, wherein the mail server includes the address conversion unit, the electronic mail reception unit, the inquiry unit, and the electronic mail transmission unit.

Nonetheless, Rannali et al discloses an electronic mail system according to claim 4, comprising: a directory server which includes the address conversion unit; and an electronic mail server which includes the electronic mail reception unit, the inquiry unit, and the electronic mail transmission unit (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of Directory Server (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32) taught by Rannali et al in Hutton et al's system, for the purpose of having a electronic mail system which aids in providing unified messaging service which includes Directory service, LDAP, fax, and mail etc, to provide users with different methods of communication.

Consider **Claim 7**, Hutton et al in view of Rannali et al discloses an electronic mail system according to claim 4, wherein it comprises of an updating unit (Fig 8, Col 10 Lines 25-35) which updates the network address included in the address conversion data by notifying the address conversion unit (Fig 8, Col 10 Lines 25-35) from the destination terminal with the terminal name of the destination terminal and the network address when the destination terminal is assigned with a network address (Fig 8, Col 10

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Lines 25-35). Hutton et al clearly shows how the system converts the addresses from the messages and its updates its database with the new addresses.

Consider **Claim 8**, Hutton et al fails to disclose the electronic mail system according to claim 4, wherein the address conversion data is a structured document. Nonetheless, Rannali clearly shows that electronic mail system uses a structured document (Rannali et al, Col 6 Lines 24-67, Col 7 Lines 1-29). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of structured documents in the system (Rannali et al, Col 6 Lines 24-67, Col 7 Lines 1-29) taught by Rannali et al in Hutton et al's system, for the purpose of data in easy accessible format, and which can be also be used by other various communication methods of the system easily.

Consider **Claim 11**, Hutton et al in view of Rannali et al clearly discloses an electronic mail system according to claim 4, wherein the address conversion unit stores an update time for the address conversion data (Col 6 Lines 55-67, Col 7 Lines 1-16), and when a prescribed period of time elapses from the update time, the address conversion unit requests a network address from the destination terminal (Col 6 Lines 55-67, Col 7 Lines 1-16). Hutton et al clearly shows on how the electronic mail system polls the time on the system for message retrieval which in turn helps the system in its polling.

Consider **Claim 12**, Hutton et al discloses the program for an electronic mail system comprising: a command for storing and managing address conversion data for

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converting an electronic mail address of a destination terminal into a network address (Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16); and a command for obtaining the network address by referring to the address conversion data by an electronic mail address (Col 10 Lines 46-56) when receiving an electronic mail of an electronic mail address, but Hutton et al fails to teach a common for obtaining the network address by referring to the address conversion data by electronic mail address when receiving an electronic mail other than that of the mailbox managed by the mail server. Nonetheless, Rannali et al clearly shows the program for an electronic mail system comprising: a command for storing and managing address conversion data for converting an electronic mail address of a destination terminal into a network address (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32, Col 7 Lines 35-38, Col 15 Lines 35-40, 42-55); and a command for obtaining the network address by referring to the address conversion data by an electronic mail address when receiving an electronic mail of an electronic mail address other than that of the mailbox managed by the mail server (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32, Col 7 Lines 35-38, Col 15 Lines 35-40, 42-55). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of a command for obtaining the network address from the LDAP or Directory Service to obtain its network address in the system taught by Rannali et al in Hutton et al's system for the purpose of obtaining network address from an electronic mail message with the use of LDAP server or Directory Server.

Consider **Claim 13**, Hutton et al fails to disclose the program for the electronic mail system according to claim 12, further comprising: a command for the destination terminal to notify a server that manages the address conversion data of a terminal name of the destination terminal and a network address when the destination terminal is assigned with a network address from a server for assigning a network address. Nonetheless, Rannali et al clearly shows the program for the electronic mail system according to claim 12, further comprising: a command for the destination terminal to notify a server that manages the address conversion data of a terminal name of the destination terminal and a network address when the destination terminal is assigned with a network address from a server for assigning a network address (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32, Col 7 Lines 35-38, Col 15 Lines 1-9, Col 16 Lines 4-6). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of a command for obtaining notification when the LDAP or Directory Service obtains the network address (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32, Col 7 Lines 35-38, Col 15 Lines 1-9, Col 16 Lines 4-6) from the system taught by Rannali et al in Hutton et al's system for the purpose of notification of events carried out by the electronic mail system.

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Claims **9 and 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hutton et al (US Pat 6,108,704), in view of Ranalli et al (US Patent 6,748,057), and in further view of. Besprosvan (US Pub 2002/0124057).

Consider **Claim 9**, Hutton et al in view of Rannali et al clearly fails to disclose the electronic mail system according to claim 4, further comprising: mailboxes for each of the destination terminals; wherein when there is no mailbox for the destination terminal included in the received electronic mail, the inquiry unit inquires the network address from the address conversion unit. Nonetheless, Besprosvan clearly discloses the electronic mail system according to claim 4, further comprising: mailboxes for each of the destination terminals (Besprosvan Pg 5, [0057], [0064]); wherein when there is no mailbox for the destination terminal included in the received electronic mail (Besprosvan Pg 5, [0055], [0057], [0064]), the inquiry unit inquires the network address from the address conversion unit (Besprosvan Pg 5, [0057], [0064]). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of a mailbox (Besprosvan Pg 5, [0057]) to store messages in the system along with storing all messages received by the system (Besprosvan Pg 5, [0055]) taught by Besprosvan, Ranali et al in Hutton et al's electronic mail system, for the purpose of storing messages in mailboxes and even when the LDAP or database server have no mailbox for users, as the system is designed to store messages when they are received.

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Consider **Claim 10**, Hutton Hutton et al in view of Rannali et al clearly fails to disclose the electronic mail system according to claim 4, further comprising: mailboxes for each of the destination terminals; wherein when the inquiry unit fails to obtain the network address from the address conversion unit by using the electronic mail address of the destination terminal included in the received electronic mail, the received electronic mail is stored in the mailbox. Nonetheless, Besprosvan clearly discloses electronic mail system according to claim 4, further comprising: mailboxes for each of the destination terminals; wherein when the inquiry unit fails to obtain the network address from the address conversion unit by using the electronic mail address of the destination terminal included in the received electronic mail, the received electronic mail is stored in the mailbox (Besprosvan Pg 5, [0057], [0064]). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of mailbox even if the system was not able to connect to the LDAP to obtain network addresses as the system does is able to provide allocation of storage resources by the system that provides reference/redirection of messages (Besprosvan Pg 5, [0055], [0057], [0064]) taught by Besprosvan, Ranali et al in Hutton et al's electronic mail system, for the purpose of storing messages in mailboxes even when LDAP or database server is not able to obtain network addresses as the system is capable of storing all messages which are directed towards it.

Conclusion

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401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Anish Sikri whose telephone number is (571) 270-1783. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Anish Sikri
A.S./a.s.

March 15, 2007

A handwritten signature in black ink, appearing to read 'Anish Sikri', with a large, stylized flourish underneath.